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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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09/900,370

07/06/2001

Noboru Takada

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02/28/2005

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EXAMINER

GENCO, BRIAN C

ART UNIT

PAPER NUMBER

2615

DATE MAILED: 02/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/900,370

Applicant(s)

TAKADA ET AL

Examiner

Brian C Genco

Art Unit

2615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7,9-17 and 19-21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 7,17 and 19-21 is/are allowed.
- 6) ☒ Claim(s) 9-14 is/are rejected.
- 7) ☒ Claim(s) 15 and 16 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Examiner thanks Applicant for amending claim 7 so as to put it in condition for allowance.

Upon further consideration of the claim limitations of claims 9-16 a new grounds of rejection are presented herein bellow based on the Cambier reference of record.

Allowable Subject Matter

Claims 7, 15-17, and 19-21 are deemed allowable over the prior art of record. See the reasons for allowance in the Office Action mailed on June 18, 2004.

Claims 15 and 16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The reasons for allowance for claim 15 is substantially similar to the reasons for allowance for claims 7, 17, and 19-21.

In regards to claim 16 the prior art of record does not disclose nor fairly suggest the combination of limitations recited in claim 16 and the claims from which it depends wherein the image pickup section includes an image pickup element for picking up the image of the iris, a connector section for coupling an external circuit detachable from the image pickup section, wherein the external circuit includes a storage for storing a reference iris information, and a comparator section for comparing an information based on the image of the iris picked up by the image pickup section with the reference iris information to output the comparison result as to whether matching is obtained.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue

fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 9, 10, 13, and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by (USPN 6,532,298 to Cambier et al.).

In regards to claim 9 Cambier discloses an iris camera module comprising:

an image pickup optical system for picking up a image of the iris of a user (e.g., Fig. 8);

and

a target optical system including a target screen for displaying a target for aligning the eye of the user (e.g., Fig. 8; Fig. 2A, wherein element 115 is the target screen; column 4, lines 52-62),

wherein the target optical system and the image pickup optical system are integrated onto a common substrate (e.g., Examiner notes that Applicant has never defined what the common substrate is in the specification. In particular, Examiner notes that the support of this claim is derived from substrate 50 illustrated in Figs. 2 and 10 of the instant invention, however, there is no discussion as to what substrate 50 is)

Examiner proposes the definition “A sheet of base material with or without an interconnection pattern and on which or within which ‘discrete components’ or integrated circuits or both can be located” as defined at www.columbia.edu/cu/mechanical/nrl/ntm/Glossary.html.

Examiner notes that according to this definition of the term substrate, the housing material of element 700 as depicted in Fig. 9A is a common substrate to the image pickup optical system and the target optical system.

Further, the telephone 575 depicted in Fig. 9A is a common substrate to the image pickup optical system and the target optical system.

Also, Examiner notes that Cambier discloses, in conjunction with the embodiment disclosed on Fig. 4 and described on column 6, lines 24-26, that the imager 100 and the microprocessor 210 can be coupled together via printed circuit boards that are incorporated into the telephone. As such, one of ordinary skill in the art would clearly recognize that the elements 700 and 570 of Fig. 8 can be coupled together via printed circuit boards wherein the printed circuit boards are the substrate).

In regards to claim 10 Cambier discloses an iris camera module according to claim 9, wherein the image pickup optical system includes:

- an infrared illuminating section for irradiating an infrared ray onto the eye (e.g., element 130 of Fig. 8; column 4, lines 25-57);

- an image pickup section for picking up the image of the iris by detecting the infrared ray reflected on the eye (e.g., element 105 of Fig. 8); and

- an image pickup optical section for guiding the infrared ray reflected on the eye to the image pickup section (e.g., element 110 of Fig. 8),

and further wherein the target optical system includes:

a target optical section for guiding the image of the target on the target screen to the eye (e.g., element 120 of Fig. 8; column 4, lines 52-62).

In regards to claim 13 Cambier discloses an iris camera module according to claim 9, wherein the target optical system includes a screen illuminating section for illuminating the target screen (e.g., element 130 of Fig. 8).

In regards to claim 14 Cambier discloses an iris camera module according to claim 10, wherein the image pickup section further includes:

an image pickup element for picking up the image of the iris (e.g., element 105 of Fig. 8);
a storage for storing a reference iris information (e.g., element 530 of Fig. 8; column 12, lines 58-60); and

a comparator section for comparing an information based on the image of the iris picked up by the image pickup section with the reference iris information to output the comparison result as to whether matching is obtained (e.g., element 500 of Fig. 8; column 12, lines 50-52).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.

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3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 11 and 12 rejected under 35 U.S.C. 103(a) as being unpatentable over (USPN 6,532,298 to Cambier et al.).

In regards to claim 11 see Examiner's notes on the rejection of claim 10. Examiner notes that Cambier discloses another embodiment for implementing the imager 101 as depicted in Fig. 2B wherein it is well within the skill of one skilled in the art to select one of the two functional equivalents of Fig. 2B or Fig. 8. As such, the image pickup optical section and the target optical section include a common half mirror (e.g., element 121 of Fig. 2B) for reflecting to guide the infrared ray reflected on the eye to the image pickup section and guiding the image of the target screen on the target screen to the eye without reflecting the image.

In regards to claim 12 see Examiners notes on the rejection of claim 11. Examiner notes that it would have been obvious to one skilled in the art to have placed element 122 where elements 111 and 106 are located in Fig. 2B and vice versa, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Further, Examiner notes that it would have been obvious to one skilled in the art to have placed element 122 where elements 111 and 106 are located in Fig. 2B and vice versa, since it has been held that a mere reversal of essential working parts of a device involves only routine skill in the art. *In re Einstein*, 8 USPQ 167.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian C. Genco who can be reached by phone at 703-305-7881 or

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by fax at 703-746-8325. The examiner can normally be reached on Monday thru Friday 8:30am to 4:30 pm. Due to the impending move of the Patent and Trademark Office this contact information will soon change. Effective on or around March 2, 2005 Brian C. Genco will be able to be reached by telephone at 571-272-7364 or by fax at 571-273-7364.

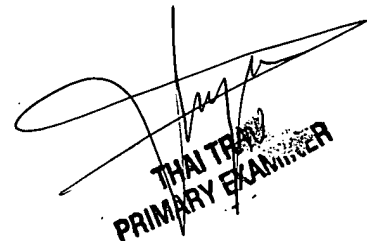
If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, Thai Tran can be reached at 703-305-4725. Effective on or around March 3, 2005 Thai Tran can be reached at 571-272-7382. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the customer service office whose telephone number is 703-308-4357.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Brian C Genco
Examiner
Art Unit 2615

February 10, 2005



THAI TRAN
PRIMARY EXAMINER